

## REMARKS

### I. Claim Rejections - 35 USC §102

#### Requirements for Prima Facie Anticipation

A general definition of *prima facie* unpatentability is provided at 37 C.F.R.

#### §1.56(b)(2)(ii):

A *prima facie* case of unpatentability is established when the information *compels a conclusion* that a claim is unpatentable under the preponderance of evidence, burden-of-proof standard, giving each term in the claim its broadest reasonable construction consistent with the specification, and before any consideration is given to evidence which may be submitted in an attempt to establish a contrary conclusion of patentability. (*emphasis added*)

"Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration." *W.L. Gore & Associates v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303, 313 (Fed. Cir. 1983) (citing *Soundsciber Corp. v. United States*, 360 F.2d 954, 960, 148 USPQ 298, 301 (Ct. Cl.), *adopted*, 149 USPQ 640 (Ct. Cl. 1966)), *cert. denied*, 469 U.S. 851 (1984). Thus, to anticipate the applicants' claims, the reference cited by the Examiner must disclose each element recited therein. "There must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention." *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 927 F.2d 1565, 18 USPQ 2d 1001, 1010 (Fed. Cir. 1991).

To overcome the anticipation rejection, the applicants need only demonstrate that not all elements of a *prima facie* case of anticipation have been met, *i.e.*, show that the reference cited by the Examiner fails to disclose every element in each of the applicants' claims. "If the examination at the initial state does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of the patent." *In re Oetiker*, 977 F.2d 1443, 24 USPQ 2d 1443, 1444 (Fed. Cir. 1992).

***Novoselsky et al.***

The Examiner stated that claims 1, 20 and 24, "as best understood," are rejected under 35 U.S. C. 1 02(b) as being anticipated by Novoselsky (4,733,432).

The Examiner argued that Novoselsky discloses a mechanism comprising a main drive spindle (43) being driven by a power supply (4) and rotatable axially; at least one eccentric element (325) being in communication with the drive spindle and producing eccentric motion; at least one bearing means surrounding the eccentric element (5:23-52); and at least one drive transmitting element (327) being configured to perform an essentially linear movement which is transformed into an orbiting motion of a final drive spindle (326), one of the terminals of the drive transmitting element being connected to the eccentric bearing means and the other terminal to the final drive spindle, the drive transmitting element passing through a drive transferring spindle bearing associated with a supporting piece connected by bearings to the main frame (Figs. 3-7); multiple eccentric elements with drive spindles; and is a cleaning tool (Figs. 1 and 3-7).

In response, the Applicant respectfully disagrees that Novoselsky teaches all of the features of the Applicant's invention. To anticipate the Applicants' claims, Novoselsky must disclose each element recited therein. "There must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention." *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 927 F.2d 1565, 18 USPQ 2d 1001, 1010 (Fed. Cir. 1991). In the present case, there are several differences between the Applicant's invention as compared to Novoselsky when viewed by a person of ordinary skill in the field of the invention. The newly amended language of claim 1 better emphasizes the differences:

1. (Currently Amended) A mechanism comprising a main drive spindle being driven by a power supply and rotatable axially; at least one eccentric element being in communication with said drive spindle and producing eccentric motion; at least one bearing means surrounding the eccentric element; ~~and~~ at least one drive transmitting element being configured to perform an essentially linear movement which is transformed into an orbiting motion for at least one of a free upper

end of a final drive spindle; one of the terminals of the drive transmitting element being connected to said eccentric bearing means and the other terminal to the final drive spindle, the drive transmitting element passing through a drive transferring spindle bearing associated with a supporting piece connected by bearings to the main frame; and, wherein the final drive spindle is essentially perpendicular to the drive transmitting element to allow the final drive spindle to create at least one cone or cylinder pattern motion.

Novoselsky fails to teach a final drive spindle that is perpendicular to the drive transmitting element (Novoselsky, Figs. 3-7). Novoselsky teaches an elliptical orbiting motion created by a displacement of the axis of its "carriers" and even creates a plurality of effect with an associated plurality of carriers; however, Novoselsky limits its teachings to the same motion on a two dimensional plane. The Applicant's invention on the other hand teaches an "eccentric element" to transfer its motion to a perpendicular final drive spindle. This is a critical difference between the two designs. While Novoselsky applies the cleaning brushes near the circumferences of the "carriers", the Applicant's invention does not. The added benefit is that, depending on the length of the perpendicular final drive spindle, the orbiting motion of a brush that would be attached to the free end of the final drive spindle will be proportionately greater in a cone pattern. Further, as illustrated in Figs. 3A - 3D, depending on the configuration of the related elements taught by claim 1, the final drive spindle can move in one or two cone pattern, or even in a cylindrical pattern. Yet another difference as illustrated in Figs. 28a - 28d, the use of multiple final drive spindles can create multiple orbits within an orbit. This is simply not taught by the reference prior art of Novoselsky.

To overcome the anticipation rejection, the applicants need only demonstrate that not all elements of a *prima facie* case of anticipation have been met, *i.e.*, show that the reference cited by the Examiner fails to disclose every element in each of the applicants' claims. "If the examination at the initial state does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of the patent." *In re Oetiker*, 977 F.2d 1443, 24 USPQ 2d 1443, 1444 (Fed. Cir. 1992). As presented above, the Applicant has effectively shown that there are fundamental differences between the Applicant's invention and Novoselsky. As such, the Applicant

respectfully requests the Examiner to withdraw the rejection to Applicant's claim 1 and all its dependent claims.

## **II. Response to Arguments**

The Examiner argued that Applicant's arguments filed 5/3/10 have been fully considered but they are not persuasive. The Examiner asserted that Applicant's arguments that the Non-Final Rejection of 2/3/10 should be withdrawn since a final decision as to the allowability of the generic claims has not yet been made is not convincing. The Examiner argued that in accordance with the requirements of MPEP 1850, since the technical features identified by Applicant do not read over the prior art (US 4,656,788 (to Rhodes et al.)); and the application contains claims directed to more than one species of the generic invention, these species are deemed to lack unity of invention because they are not so linked so as to form a single general inventive concept under PCT Rule 13.1. (See MPEP 1850).

In response, the Applicant respectfully requests the Examiner to reconsider his decision in light of the arguments presented above and asserts that the claims as amended are not directed to more than species of a generic invention. Further, the Examiner is silent with respect to the claims dependent on the three allowed claims. The Applicant respectfully requests allowance of the three allowed claims and any dependent claims thereof.

## **III. Conclusion**

In view of the foregoing discussion and the detailed response provided in response to the previous final office action, the Applicant has responded to each and every rejection of the Final Official Action. The Applicant has clarified the structural distinctions of the present invention. The Applicant respectfully request the withdrawal of the aforementioned rejections under 35 U.S.C. §102 based on the preceding

remarks. Reconsideration of the Non-final Rejection of 2/3/10 is also respectfully solicited.

Should there be any outstanding matters that need to be resolved in the present application; the Examiner is respectfully requested to contact the undersigned representative to conduct an interview in an effort to expedite prosecution in connection with the present application.

Respectfully submitted,



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